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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/709,704	11/09/00	TREUHEIT	M A-584

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EXAMINER

SISSON, B

ART UNIT

PAPER NUMBER

1655

DATE MAILED:

05/08/01

**Please find below and/or attached an Office communication concerning this application or proceeding.**

**Commissioner of Patents and Trademarks**

# Office Action Summary

Application No.

09/709,704

Applicant(s)

TREUHEIT ET AL.

Examiner

Bradley L. Sisson

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 20 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-31 is/are pending in the application.
- 4a) Of the above claim(s) 3, 8-13, 16-27, 29, and 31 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) \_\_\_\_\_ is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☒ Claims 1-31 are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☒ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☐ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 18) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: \_\_\_\_\_.

Response to Election

Acknowledgement is made of applicant having provided a response to the election requirement of 20 February 2001. Upon further consideration of applicant's traversal, the previous election requirement is hereby withdrawn. A new restriction requirement follows.

***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-16, 28, and 30, drawn to a process for preparing a pharmaceutically active compound, classified in class 514, subclass 2.
  - II. Claims 17-27, 29, and 31, drawn to a process for preparing a pharmacologically active compound, classified in class 514, subclass 2.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are unrelated. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions are comprised of different method steps and do not require the reactants as set forth in the various methods.
3. Because these inventions are distinct for the reasons given above and have acquired a separate status in the art because of their recognized divergent subject matter, restriction for examination purposes as indicated is proper.

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4. This application contains claims directed to the following patentably distinct species of the claimed invention: In the even that applicant elects the invention set forth in Group I, the following election of species would apply:

- a. Whether the pharmacologically active compound comprises
  - i. A pharmacologically active site, or
  - ii. An antibody
- b. If (i.) above is selected, then the following election is required:
  - ii. OPG protein;
  - iii. Leptin protein;
  - iv. TNF- $\alpha$  inhibitor;
  - v. IL-1 inhibitor, including IL-1ra protein; and
  - vi. TPO-mimetic peptide.
- c. Irrespective of the election in "a." and "b.", above, applicant is required to elect between the following:
  - i. Pharmacologically active compound is prepared in *E. coli* or
  - ii. Pharmacologically active compound is prepared in CHO cells.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 1, 4, 6, 7, 28 and 30 are generic for Group I.

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4. This application contains claims directed to the following patentably distinct species of the claimed invention: In the event that applicant elects the invention of Group II, the following election of species applies:

- a. Whether the pharmacologically active compound comprises
  - i. A pharmacologically active site, or
  - ii. An antibody
- b. If (i.) above is selected, then the following election is required:
  - i. OPG protein;
  - ii. Leptin protein;
  - iii. TNF- $\alpha$  inhibitor;
  - iv. IL-1 inhibitor, including IL-1ra protein; and
  - v. TPO-mimetic peptide.
- c. Irrespective of the election in "a." and "b." above, applicant is required to elect between the following:
  - i. Pharmacologically active compound is prepared in *E. coli* or
  - ii. Pharmacologically active compound is prepared in CHO cells.

Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable. Currently, claims 17, 29, and 31 are generic.

Applicant is advised that a reply to this requirement must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable

thereon, including any claims subsequently added. An argument that a claim is allowable or that all claims are generic is considered nonresponsive unless accompanied by an election.

Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, applicant must indicate which are readable upon the elected species. MPEP § 809.02(a).

Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

4. During a telephone conversation with Timothy J. Gaul, reg. No. 33,111, on 30 April 2001 a provisional election was made with traverse to prosecute the invention of Group I, with the election of species a(i), b(iv), and c(i). Affirmation of this election must be made by applicant in replying to this Office action. Claims 3, 8-13, 16-27, 29, and 31 have been withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

5. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the

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application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

### *Sequence Rules Compliance*

6. This application contains sequence disclosures that are encompassed by the definitions for nucleotide and/or amino acid sequences set forth in 37 CFR 1.821(a)(1) and (a)(2). However, this application fails to comply with the requirements of 37 CFR 1.821 through 1.825 for the reason(s) set forth on the attached Notice To Comply With Requirements For Patent Applications Containing Nucleotide Sequence And/Or Amino Acid Sequence Disclosures. Applicant must comply with the requirements of the sequence rules (37 CFR 1.821 - 1.825) before the application can be examined under 35 U.S.C. §§ 131 and 132.

### *Specification*

7. The disclosure is objected to because of the following informalities: The specification does not contain as a first paragraph, a claim to benefit of priority to any application. Upon review of the declaration, it would appear that applicant is claiming benefit of priority to a provisional application.

Appropriate correction is required.

8. The use of the trademark TWEEN has been noted in this application. It should be capitalized wherever it appears and be accompanied by the generic terminology.

Although the use of trademarks is permissible in patent applications, the proprietary nature of the marks should be respected and every effort made to prevent their use in any manner which might adversely affect their validity as trademarks.

9. The incorporation of essential material in the specification by reference to a foreign application or patent, or to a publication is improper. Applicant is required to amend the disclosure to include the material incorporated by reference. The amendment must be accompanied by an affidavit or declaration executed by the applicant, or a practitioner representing the applicant, stating that the amendatory material consists of the same material incorporated by reference in the referencing application. See *In re Hawkins*, 486 F.2d 569, 179 USPQ 157 (CCPA 1973); *In re Hawkins*, 486 F.2d 579, 179 USPQ 163 (CCPA 1973); and *In re Hawkins*, 486 F.2d 577, 179 USPQ 167 (CCPA 1973).
10. The attempt to incorporate subject matter into this application by reference to WO, EP, and FR patent documents (page 13) is improper because said documents are relied upon for disclosing IL-1 inhibitors, the elected species.

#### ***Claim Rejections - 35 USC § 112***

11. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

12. Claims 1, 2, 4-7, 14, 15, 28, and 30 are rejected under 35 U.S.C. 112, first paragraph, as containing subject matter which was not described in the specification in such a way as to enable



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one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Factors to be considered in determining whether a disclosure would require undue experimentation have been summarized in *In re Wands*, 8 USPQ2d 1400 (CAFC 1988). They include (1) the quantity of experimentation necessary, (2) the amount of direction or guidance presented, (3) the presence or absence of working examples, (4) the nature of the invention, (5) the state of the prior art, (6) the relative skill of those in the art, (7) the predictability or unpredictability of the art, and (8) the breadth of the claims.

*The Quantity of Experimentation Necessary*

The quantity of experimentation need is great, on the order of several man-years and then with little, if any, reasonable expectation of success.

*The Amount of Direction or Guidance Provided*

The amount of guidance provided is to a great extent reliant upon the improper incorporation by reference to published documents that are not issued US patents. Even if the documents incorporated by reference were US patents, the specification is essentially silent as to how the prior art compounds are to be adapted so to be used in the claimed procedure and to result in a useful product.

*The Presence or Absence of Working Examples*

The specification has been found to provide but two examples and neither of which are directed to the elected species. Accordingly, the subject application does not set forth the starting

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materials and reaction conditions that must be employed in practicing the claimed invention.

The situation at hand is analogous to that in *Genentech v. Novo Nordisk A/S* 42 USPQ2d 1001.

As set forth in the decision of the Court:

“ ‘[T]o be enabling, the specification of a patent must teach those skilled in the art how to make and use the full scope of the claimed invention without undue experimentation.’ *In re Wright* 999 F.2d 1557, 1561, 27 USPQ2d 1510, 1513 (Fed. Cir. 1993); *see also Amgen Inc. v. Chugai Pharms. Co.*, 927 F. 2d 1200, 1212, 18 USPQ2d 1016, 1026 (Fed Cir. 1991); *In re Fisher*, 427 F. 2d 833, 166 USPQ 18, 24 (CCPA 1970) (‘[T]he scope of the claims must bear a reasonable correlation to the scope of enablement provided by the specification to persons of ordinary skill in the art.’). ”

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“Patent protection is granted in return for an enabling disclosure of an invention, not for vague intimations of general ideas that may or may not be workable. *See Brenner v. Manson*, 383 U.S. 519, 536, 148 USPQ 689, 696 (1966) (starting, in context of the utility requirement, that ‘a patent is not a hunting license. It is not a reward for the search, but compensation for its successful conclusion.’) Tossing out the mere germ of an idea does not constitute enabling disclosure. While every aspect of a generic claim certainly need not have been carried out by an inventor, or exemplified in the specification, reasonable detail must be provided in order to enable members of the public to understand and carry out the invention.

“It is true . . . that a specification need not disclose what is well known in the art. *See, e.g., Hybritech, Inc. v. Monoclonal Antibodies, Inc.*, 802 F.2d 1367, 1385, 231 USPQ 81, 94 (Fed. Cir. 1986). However, that general, oft-repeated statement is merely a rule of supplementation, not a substitute for a basic enabling disclosure. It means that the omission of minor details does not cause a specification to fail to meet the enablement requirement. However, when there is no disclosure of any specific starting material or any of the conditions under which a process can be carried out, undue experimentation is required; there is a failure to meet the enablement requirement that cannot be rectified by asserting that all the disclosure related to the process is within the skill of the art. It is the specification, not the knowledge of one skill in the art, that must supply the novel aspects of an invention in order to constitute adequate enablement. This specification provides only a starting point, a direction for further research. (emphasis added)

*The Nature of the Invention*

The claimed invention relates directly to matters of physiology and chemistry, which are inherently unpredictable and as such, require greater levels of enablement. As noted in *In re Fisher* 166 USPQ 18 (CCPA, 1970):

In cases involving predictable factors, such as that, once imagined, other embodiments can be made without difficulty and their performance characteristics predicted by resort to known scientific laws. In cases involving unpredictable factors, such as most chemical reactions and physiological activity, the scope of enablement obviously varies inversely with the degree of unpredictability of the factors involved.

*The State of the Prior Art*

The state of the prior art as it relates to the use of copper (II) halide use in preparing or modifying a Fc-IL-1, including Fc-IL-1ra, wherein “IL-1ra” is to incorporate not only IL-1ra but “variants and derivatives thereof”<sup>1</sup>, is extremely limited.

*The Relative Skill of Those in the Art*

The relative skill of those in the art that is most closely associated with the claimed invention is high, on par with those that hold a Ph.D. in biochemistry.

*The Breadth of Scope of the Claims*

As indicated above, the claimed process for preparing a pharmacologically active compound encompasses a genus of compounds. The specification has not been found to provide

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<sup>1</sup> Specification at page 14, first full paragraph.

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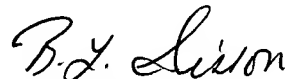
an adequate description that applicant possessed the required starting materials at the time of filing, much less provide a disclosure that would enable a skilled artisan to practice the full scope of the invention. While the specification does provide two examples, neither is drawn to the elected invention.

### *Conclusion*

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley L. Sisson whose telephone number is (703) 308-3978. The examiner can normally be reached on 6:30 a.m. to 5 p.m., Monday through Thursday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, W Gary Jones can be reached on (703) 308-1152. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-3592 for regular communications and (703) 308-0294 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

  
Bradley L. Sisson  
Primary Examiner  
Art Unit 1655

BLS  
April 30, 2001